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LUMEN INTELLECTUAL
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SEP 30 2004

OFFICE OF PETITIONS

In re Application of
Grigorov, et al. :
Application No. 10/685,993 :
Filed: 14 October, 2003 :
Attorney Docket No. RTS-103/CIP :

ON PETITION

This is a decision on the petition under ¶(a) of 37 C.F.R. §1.47, filed on 3 August, 2004.

The petition is **DISMISSED**.

NOTES:

- (1) Any reply must include a renewed petition (and fee) must include a petition under 37 C.F.R. §1.47 and must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 C.F.R. §1.47";
- (2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates:

- the application was filed on 14 October, 2003, without, *inter alia*, a fully executed oath or declaration;

- the Office mailed a Notice of Missing Parts (*inter alia*, oath/declaration) on 1 April, 2004, with a response due absent extension of time on or before 1 June, 2004;
- on 3 August, 2004, Petitioner filed (without benefit of a certificate of mailing under 37 C.F.R. §1.8 or a general fee authorization), *inter alia*, a request and fee for a two- (2-) month extension of time, an oath/declaration signed by co-inventors A. Ze'ev Hed, Dmitry N. Rogachev, Kevin P. Shambrook and Alan W. Tamarelli on behalf of themselves and the non-signing inventor Leonid N. Grigorov, along with the petition of Tianhau Gu (Reg. No. 52,480) and the statement of Michael H. Shambrook (company secretary) and copies statements of Email exchanges—but not the actual documents or transmittal letters;
- while it is somewhat unclear as to whether Petitioner transmitted only the oath/declaration, and not the entire application (specification: description abstract claims and drawings) to the non-signing inventor Mr. Grigorov, what is clear is that a reply was due on or before 1 June, 2004, and Petitioner obtained an extension of time through Monday, 2 August, 2004, but did not file the reply until Tuesday, 3 August, 2004—thus, the application appears to have gone abandoned prior to the filing of the instant petition.

ANALYSIS

The regulations at 37 C.F.R. §1.47 provide in pertinent part:

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

(a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § 1.17(h), and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

* * *

The regulations at 37 C.F.R. §1.63 provide in pertinent part:

§1.63 Oath or declaration.

(b) In addition to meeting the requirements of paragraph (a)of this section, the oath or declaration must also:

(1)Identify the application to which it is directed;

- (2) State that the person making the oath or declaration has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration; and
- (3) State that the person making the oath or declaration acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Thus, a copy of the entire application must be sent to the last known address of the non-signing inventor (or the estate representative) with a request that he/she sign the declaration for the patent application--and evidence of that transmittal submitted.

And a reasonable effort must be made to ascertain a current or last known address.

Alternatively, an oath or declaration for the patent application in compliance with 37 C.F.R. §§1.63 and 1.64 must be presented.

The declaration must set forth the inventor's residence, citizenship and post office address. An oath or declaration in compliance with 37 C.F.R. §§1.63 and 1.64 signed by the Rule 1.47 applicant is required.¹

CONCLUSION

The materials submitted thus far--because they are restatements of documents and not the documents themselves are unclear as to whether Petitioner provided a copy of the entire application to the non-signing inventor. Moreover, as noted above, it appears that the application went abandoned when Petitioner failed to reply on or before 2 August, 2004, and there was no certificate of mailing or general authorization for fees for an extension of time.

Petitioner must revive the instant application. Petitioner should submit a copy of the transmittal letter and should state the address in the petition over Petitioner's signature and registration number.

Therefore, the instant petition hereby is dismissed.

Further correspondence with respect to this matter should be addressed as follows:

¹ See: MPEP 409.03(b).

By mail: (Effective 1 May, 2003)²
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Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-314.



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² To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.